

Appl. No. : 10/066,414  
Filed : February 1, 2002

IN THE CLAIMS:

✓  
Please cancel Claim 19 without prejudice or disclaimer.

Please replace Claims 2 and 11 with the following versions of Claims 2 and 11 which have been corrected in accordance with the Certificate of Correction dated August 21, 2001:

24  
2. (Original) The exhaust system in accordance with claim 1, wherein there is a separate exhaust manifold associated with each cylinder bank, each of said exhaust manifolds having a collector section terminating at a common outlet formed at the lower end of said engine.

35  
11. (Original) The exhaust system for an engine having a cylinder block having a first cylinder head connected thereto and cooperating therewith to define a first cylinder bank containing at least one cylinder and a second cylinder head connected thereto and cooperating therewith to define a second cylinder bank containing at least one cylinder, said first and second banks arranged generally in a "V" shape and having a valley therebetween a main exhaust passage defined within said valley by said cylinder heads and cylinder block and extending through said valley to an end of said engine and at least one passage extending from each cylinder through its respective cylinder head inwardly to said main exhaust passage, said engine including a lubricant passage and a coolant passage extending through said valley, said coolant passage being positioned between said lubricant passage and said main exhaust passage.

Please amend Claim 13 as follows:

13. (Amended) An outboard motor comprising an engine, said engine having a cylinder block and at least one cylinder head, at least two cylinders defined within said cylinder block and said cylinder block being mounted generally above an exhaust guide, a cylinder head exhaust passage communicating with both of said cylinders through said cylinder head, said exhaust guide including an exhaust guide passage, said cylinder block including a cylinder block exhaust passage, and said exhaust guide passage and said cylinder head exhaust passage being in communication with each other through said cylinder block exhaust passage.

19. (Cancelled)

**Appl. No.** : **10/066,414**  
**Filed** : **February 1, 2002**

#### COMMENTS

Claims 1-18 and 20 remain pending in the present application, Claim 19 having been cancelled without prejudice or disclaimer, and Claim 13 having been amended. Claims 2 and 11 have been re-submitted including the corrections (without underlining) set forth in the Certificate of Correction dated August 21, 2001.

The claims set forth above include underlining to show the changes made relative to the **issued patent**, in accordance with 37 C.F.R. 1.173(b)(2). Because Claim 13 was added as a new claim in the original reissue application, the entire text of the amended version Claim 13 set forth above is underlined in totality. Additionally, because Claims 2 and 11 were corrected by way of the Certificate of Correction dated August 21, 2001, they do not include any underlining or brackets, as requested in paragraph number 5, page 3 of the Office Action dated November 20, 2002.

Additionally, a separate sheet is attached hereto entitled "AMENDMENTS WITH MARKINGS SHOWING CHANGES MADE" which includes a copy of amended Claim 13 showing the changes made relative to the original reissue application in which Claim 13 was originally added as a new Claim. This additional copy of Claim 13 is for the Examiner's convenience. Additionally, Applicants also submitted this additional marked-up copy of Claim 13 to aid satisfying the requirement that an applicant must "point out what is changed in the 'Remarks' portion of the amendment." MPEP § 1453 (p. 1400-58).

Applicants would also like to thank Examiner Basinger for the courteous interview extended to Applicants' counsel, Michael Guiliana, on May 21, 2003. During the interview, Applicants' counsel explained that an Amendment was filed on May 20, 2003. Additionally, Applicants' counsel explained why the presently pending claims (as amended via the Amendment filed May 20, 2002) clearly and non-obviously define over the prior art and explained why the claims are fully supported by the original specification. The substance of the interview is reflected in the comments set forth below.

On the basis of the interview and the response to the Office Action mailed November 20, 2002, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the following supplemental comments.

**Appl. No.** : **10/066,414**  
**Filed** : **February 1, 2002**

Substance of Interview of May 21, 2003

The present Notice of Non-Responsiveness indicates that the response filed "May 23, 2003" was not fully responsive because, among other reasons, it did not include a complete or accurate record of the interview of May 21, 2003. However, Applicants wish to point out that the Response was actually filed May 20, 2003, one day before the interview of May 21, 2003. Thus, the response of May 20, 2003 could not have possibly contained a record of the May 21, 2003 interview.

Rather, the Supplemental Response filed June 11, 2003 contained a record of the May 21, 2003 interview. However, in order to expedite prosecution of the present application, and for the Examiner's convenience, Applicant has reproduced herein the comments submitted with the June 11, 2003 Supplemental Response.

All Pending Claims Fully Comply With 35 U.S.C. §§ 112 and 251

Claims 13-20 stand rejected under 35 U.S.C. § 112 1<sup>st</sup> paragraph as not being enabled, and under § 251 as being based on new matter. Applicants respectfully traverse this rejection.

It is well established that "[t]he claims in [a] reissue application must be for subject matter which the applicant had the right to claim in the original patent." MPEP § 1411.02. Further, it is well established that an applicant has the right to claim any subject matter properly disclosed in a patent application.

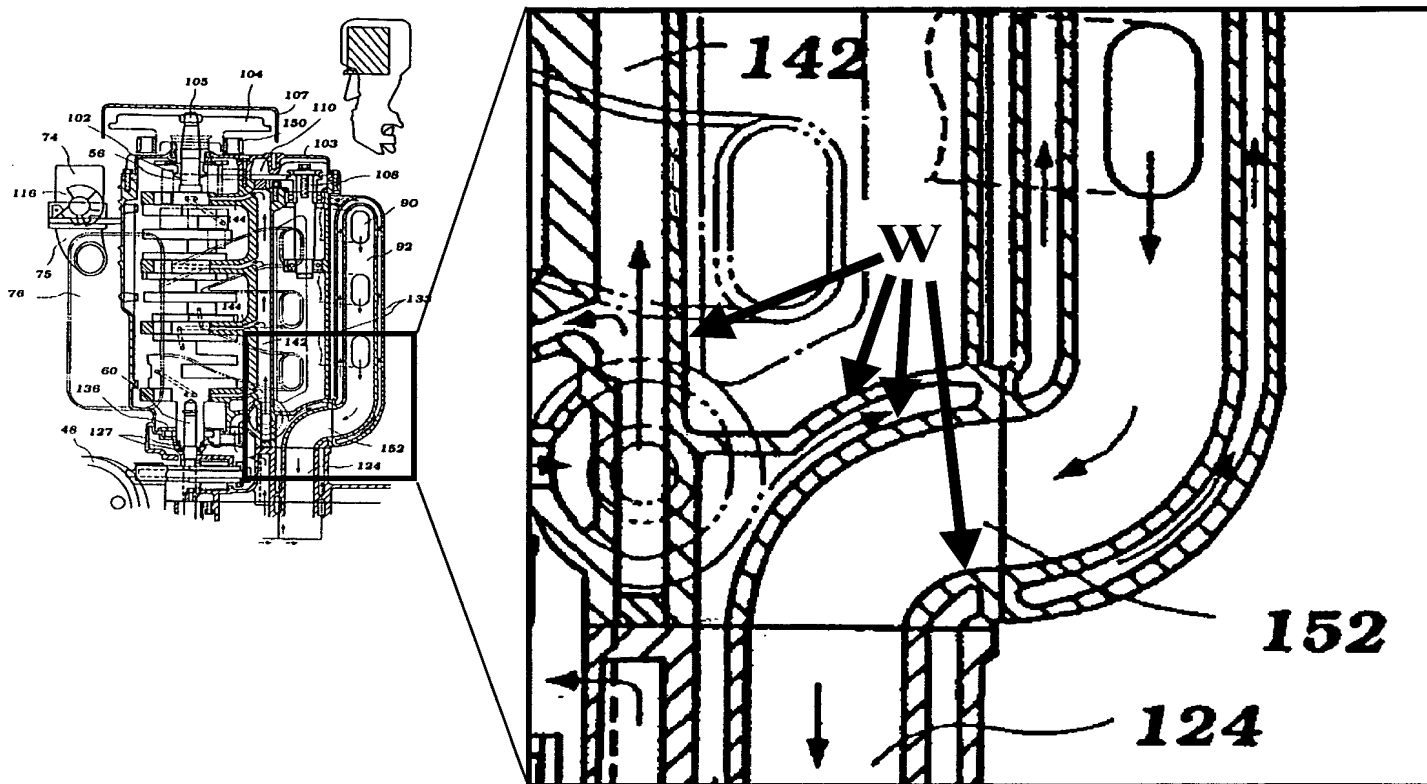
It is also well established that:

"To comply with the written description requirement of 35 U.S.C. 112, para.1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or **inherently** supported in the originally filed disclosure. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed.Cir.1998).

MPEP § 2163 (emphasis added).

Appl. No. : 10/066,414  
Filed : February 1, 2002

During the interview, Applicant's counsel pointed out that the original specification and drawings, when taken together, would convey to one of ordinary skill in the art that the passage 152 illustrated in Figure 2, necessarily passes through the cylinder block of the engine illustrated therein.



For example, as shown in the above reproduction and enlargement of Figure 2 of the present application, the walls defining a the passage 152 are formed monolithically with the cylinder block 52. In the enlarged portion of Figure 2 set forth above, certain walls, shown in cross-section, of the cylinder block 52 have been identified with a letter "W." All of these walls W are illustrated with the same cross-hatching, indicating that they are formed in the same part. Additionally, that the main oil gallery identified by the reference numeral 142 and illustrated in the upper left hand portion of the enlargement of Figure 2 set forth above, is formed monolithically with the other walls labeled "W".

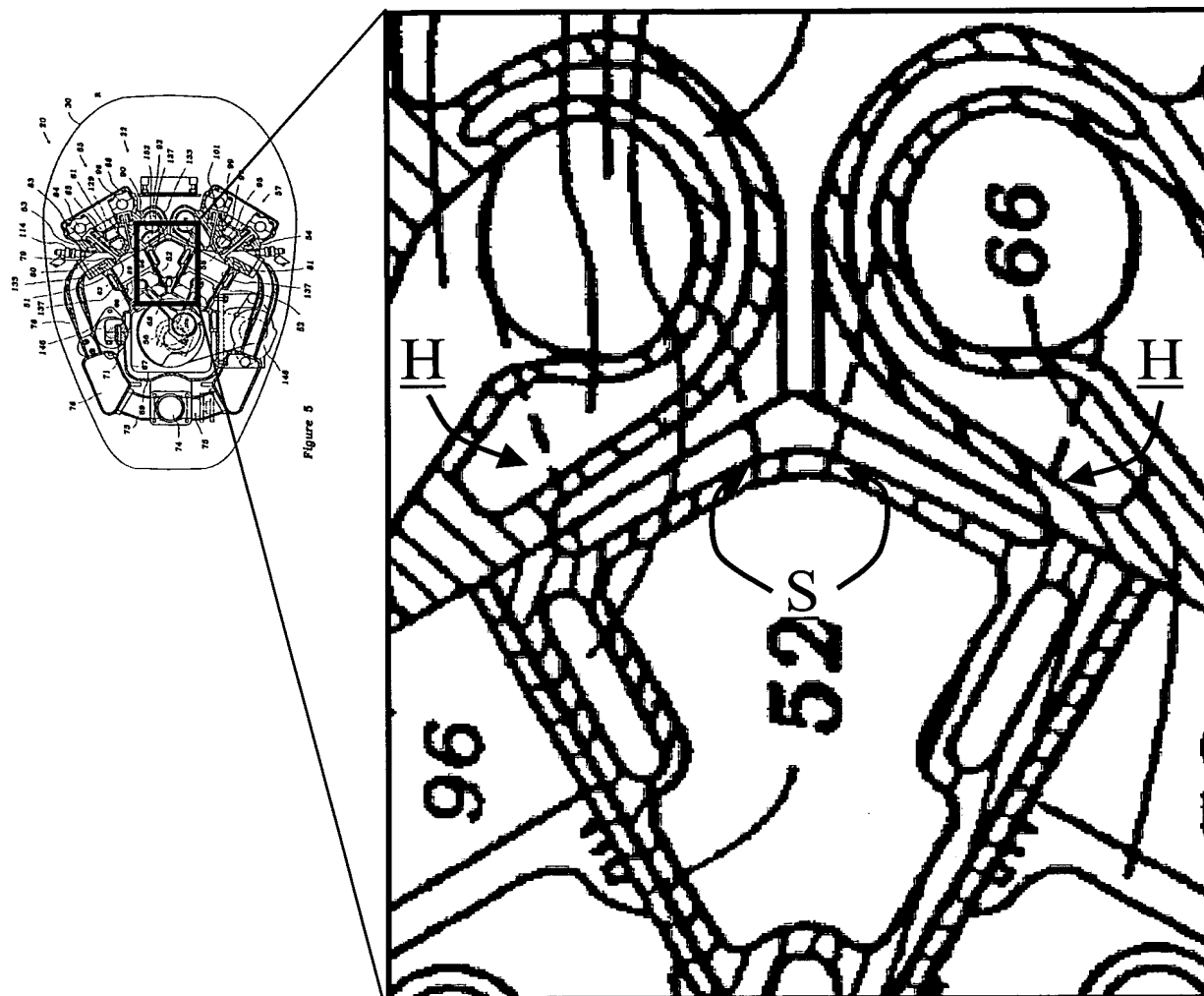
**Appl. No.** : **10/066,414**  
**Filed** : **February 1, 2002**

The specification makes clear that the main gallery 142 is defined within the cylinder block 52. For example, Applicants respectfully direct the Examiner to the right-hand column of page 2 of the present application, at lines 62-63 where it is disclosed that “the crankshaft 56 is journaled for rotation with respect to the cylinder block 52.” As shown in Figure 2 of the present application, the crankshaft 56 is illustrated as extending vertically and being supported by main bearing journals (unnumbered). Additionally, in the left-hand column of page 4 of the present application, at lines 20-21, it is disclosed that “branch passages 144 extend from the main gallery 142 for providing lubricant to crankshaft bearings and the like.

Applicants submit that in light of the disclosure of the main gallery 142 and the lubrication of the crankshaft bearings, one of ordinary skill in the art would necessarily conclude that the main gallery 142 is defined within the cylinder block. Thus, in light of the illustration of the walls of the exhaust passage 152 being formed monolithically with the main gallery 142, one of ordinary skill in the art would also conclude that the exhaust passage 152 is necessarily defined by the cylinder block 52.

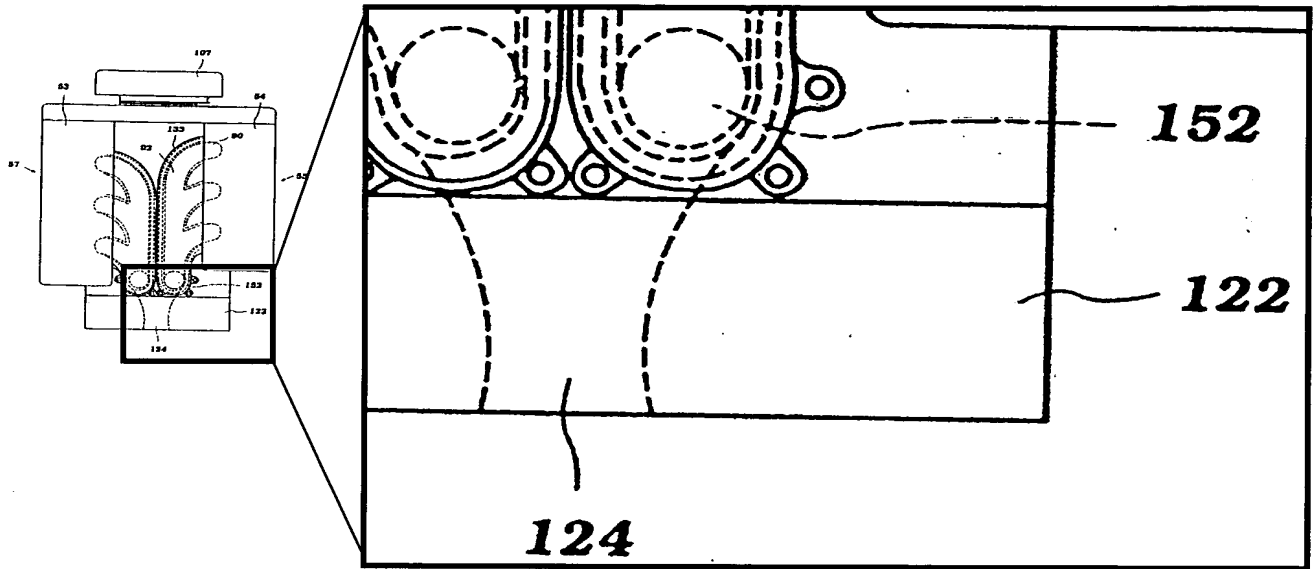
Appl. No. : 10/066,414  
Filed : February 1, 2002

Further support for the Applicants' position that one of ordinary skill in the art would necessarily conclude that the passage 152 is indeed formed in the cylinder block 52, is provided by the illustrations of Figures 5 and 6.



As shown in the above reproduction and enlargement of Figure 5, the exhaust passages 92 which extend downwardly through the cylinder heads along the back side of the engine, curve inwardly toward the cylinder block 52 at the bottom end thereof. In the above enlargement of Figure 5, hidden lines extending from the solid line illustration of the exhaust passages 92, are identified with a letter "H." The remainder of this portion of the passages 92 are illustrated in solid line, identified by the letter "S." Applicants submit that one of ordinary skill in the art would recognize that these hidden and solid lines indicate the inward extension of the exhaust

passages 92 toward the cylinder block 52. Further, the portion of these lines identified with the letter “S,” show that the passages 92 terminate at the cylinder block 52.



Finally, with reference to the above enlarged reproduction of Figure 6, the opening of the passage 152 is illustrated in phantom line having a circular cross section. The position of these hidden lines at the lower end of the cylinder block, just above the exhaust guide plate 122, correspond to the hidden H and solid S lines identified above with reference to the enlargement of Figure 5.

Additionally, as shown in the enlargement of Figure 6 above, the lower end of the passages 92 are secured to a portion of the engine with bolt flanges (unnumbered). Thus, Applicants submit that one of ordinary skill in the art would conclude that these bolt flanges are intended to connect the exhaust passages to the portion of the cylinder block 52 that extends between the cylinder banks, as illustrated in the above enlargement of Figure 5. Thus, Applicants submit that Claim 13 is fully supported by the present specification and does not constitute new matter.

Further to the comments regarding claims 17 and 18 set forth in the Amendment filed May 29, 2003, Applicants wish to point out that the above enlargement of Figure 6 shows the branch portions merging into a common passage.

**Appl. No.** : **10/066,414**  
**Filed** : **February 1, 2002**

Prior Art Rejections

The response filed May 20, 2003 addressed each of the rejections of the claims over the cited prior art including the Ziegler, Nakai et al., and Isogawa references. The comments set forth in the previously filed amendment with respect to these rejections reflects the substance of the interview with respect to these rejections. For the Examiner's convenience, Applicants have reproduced below the same remarks submitting in the response filed May 20, 2003.

Ziegler Does Not Anticipate Claims 13 and 15

Claims 13 and 15 stand rejected under 35 U.S.C. § 102(b) as anticipated by Ziegler. Applicants respectfully traverse the present rejection.

Ziegler only discloses two-stroke engines. Thus, none of the exhaust passages in Ziegler extend through the cylinder head. In contrast, Claim 13, among other limitations, recites "a cylinder head exhaust passage communicating with both of said cylinders through said cylinder head." Thus, Ziegler cannot anticipate Claims 13 or 15.

Nakai et al. Does Not Anticipate Claims 13 and 14

Claims 13 and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Nakai et al. Applicants respectfully traverse the present rejection.

Nakai et al. discloses exhaust system designs in which exhaust passages from each cylinder are connected directly with an exhaust manifold formed in the cylinder block. In contrast, Claim 13 recites, among other features, "at least two cylinders defined within said cylinder block and said cylinder block being mounted generally above an exhaust guide, a cylinder head exhaust passage communicating with both of said cylinders through said cylinder head." Thus, Nakai et al. cannot anticipate Claims 13 or 14.

Isogawa Does Not Anticipate Claims 16-18 or 20

Claims 16-18 and 20 stand rejected under 35 U.S.C. § 102(b) as anticipated by Isogawa. Applicants respectfully traverse the present rejection.

Isogawa only discloses specific exhaust system designs for two-stroke engines. None of the exhaust ports in Isogawa are disposed in the cylinder head. In contrast, Claim 16 recites, among other limitations, "said cylinder head assembly comprising at least one exhaust port." Thus, Isogawa does not anticipate Claim 16.



**Appl. No.** : **10/066,414**  
**Filed** : **February 1, 2002**

Response to Drawing Objection

Figures 3, 8, and 20 stands objected to for containing informalities. In response, Applicants request that Figures 3, 8, and 20 be amended as shown in the attached copies of those Figures with changes shown in red. Additionally, as requested in the Notice of Non-Responsiveness, Applicants have included a request to add the word "Amended" to each of these figures.

Response to Rejection Based on Defective Declaration Under 35 U.S.C. § 251.

Applicants filed a supplemental Reissue Declaration in compliance with 35 U.S.C. § 251 with the Supplemental Response dated June 11, 2003. Thus, the present rejection is moot.

Certificate of Correction

Applicants have also filed herewith the Certificate of Correction dated August 21, 2001 in accordance with paragraph number 6 on page three of the Office Action dated November 20, 2002.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims and specification. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

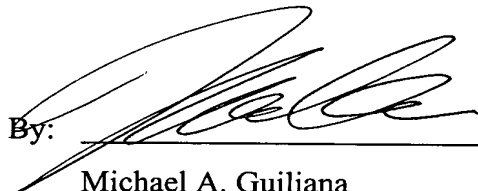
The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped

**Appl. No.** : **10/066,414**  
**Filed** : **February 1, 2002**

issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

Respectfully submitted,  
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 21, 2003

By: 

Michael A. Guiliana  
Registration No. 42,611  
Attorney of Record  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
(949) 760-0404